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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77589558
Applicant	Adventist Health System/Sunbelt, Inc.
Applied for Mark	HEALTH VILLAGE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application for	"HEALTH VILLAGE")	Law Office 108
)	
Serial No.:	77/589558)	Trademark Attorney
)	Heather A. Sapp
Filed:	October 9, 2008)	
)	
Applicant:	Adventist Health System/Sunbelt, Inc.)	
)	

BRIEF FOR APPELLANT

INTRODUCTION

Applicant hereby appeals from the Examining Attorney's refusal to register (allow) the above-identified mark dated February 23, 2009, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision.

APPLICANT'S TRADEMARK

Applicant seeks registration on the Principal Register of its mark, HEALTH VILLAGE, for "physical fitness centers, exercise rooms, spas, indoor recreation facilities, schools and colleges."

The Examining Attorney did not cite any prior registrations against Applicant's mark.

PROCEDURAL HISTORY

The Examining Attorney initially refused registration of Applicant's mark by an Office Action dated October 15, 2008, contending that Applicant must disclaim a portion of the mark that the Examining Attorney considered to be merely descriptive. The Examining Attorney required Applicant to disclaim the term "HEALTH" because, in her opinion, it merely described the subject matter of the services offered by Applicant. In Applicant's response to the initial refusal to register, filed on January 30, 2009, Applicant demonstrated that the term "HEALTH"

was suggestive, not merely descriptive, because the term suggests a possible “healthy” outcome available by using the services without specifically describing any services themselves.

The Examining Attorney further expounded her position in a Final Office Action, dated February 23, 2009, finding Applicant’s argument to be unpersuasive and reiterated her belief that “HEALTH” is merely descriptive of Applicant’s offered services. Furthermore, the Examining Attorney attached eight third-party registrations to the Final Office Action to demonstrate probative evidence on the issue of descriptiveness.

In a Request for Reconsideration, filed on June 12, 2009, Applicant established that there is no conclusive evidence that “HEALTH” is descriptive based on disclaimers of other applicants and offered numerous third-party registrations featuring similar services that did not disclaim the term “HEALTH.” Nonetheless, the Examining Attorney denied Applicant’s Request for Reconsideration on June 15, 2009, maintaining her refusal despite Applicant’s submission of additional arguments and evidence to the contrary.

THE ISSUE

The sole issue presented by this appeal is whether the Examining Attorney has established that the term “HEALTH” as used in Applicant’s mark is merely descriptive of the services to be offered by Applicant that would require a disclaimer by Applicant.

ARGUMENTS

“It has been long acknowledged that there is a very narrow line between terms which are merely descriptive and those which are only suggestive,” and the borderline between the two is hardly a clear one. In re Atavio Inc., 25 U.S.P.Q.2d 1361, 1362 (T.T.A.B. 1992). Where there are doubts as to registrability of marks, particularly in “dealing with a fine and frequent subject line of demarcation between suggestive and the merely descriptive designation,” doubts in such

cases are to be resolved in favor of applicant. In re Officers' Organization for Economic Benefits, Ltd., 221 U.S.P.Q. 184, 186 (T.T.A.B. 1983).

I. THE EXAMINING ATTORNEY FAILED TO MEET HER BURDEN OF PROOF THAT THE TERM "HEALTH" IS MERELY DESCRIPTIVE OF THE SERVICES TO BE OFFERED BY APPLICANT.

"Generally speaking, if the mark imparts information directly, it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive." Union Carbide Corp. v. Ever-Ready Inc., 188 U.S.P.Q. 623, 635 (T.T.A.B. 1976)(quoting A. Seidel, S. Saloff, and E. Gonda, Trademark Law and Practice § 4.06 at 77 (1963)).

Applicant's use of the term "HEALTH" in its mark does not describe the services to be offered and is merely suggestive of the services to be offered under the mark. Specifically, Applicant intends to offer services that are mere factors or elements that when used may result in or impact good personal well-being. The use of the term "HEALTH" is suggestive of the outcome available by utilizing these services to be offered under the mark, and does not specifically describe the services themselves. Therefore, the Examining Attorney's concern that the use of "HEALTH" in Applicant's mark is merely descriptive of Applicant's services is unfounded, and the requested disclaimer unnecessary.

A. The term "HEALTH" neither directly imparts information about Applicant's listed services nor describes or modifies any of the listed services.

The Merriam-Webster's Dictionary (2008) defines "health" as the condition of being sound in body, mind, or spirit. Dorland's Medical Dictionary (1994) defines "health" as a state of optimal physical, mental, and social well-being, and not merely the absence of disease and infirmity. Thus, "health" is a condition or outcome to be achieved. For example, one uses an indoor recreation facility to become physically healthy. Although Applicant intends to offer

services that may be expected to result in “health,” Applicant will not sell or offer “health,” which is defined as the state of optimal physical, mental, and social well-being. The fact that the term “HEALTH” in the mark suggests that the Applicant’s services may result in or impact personal well-being does not make the term merely descriptive; instead, Applicant uses the term suggestively to evoke the intended condition or outcome from using its services.

Moreover, the same Examining Attorney found “HEALTH” is not descriptive by allowing registration of Applicant’s mark “HEALTH VILLAGE” (Serial No. (77/589566) for “adult and child day care services; assisted living facility; community residential home services; restaurant and café services; hotel and motel services; convention, exhibition and meeting facilities services” without requiring disclaimer by Applicant.

In contrast to the terms “physical fitness,” “exercise,” “recreation,” or “school” that would actually describe the listed services, use of the term “HEALTH” will not specifically describe the services themselves. Alternatively, the term “HEALTH” suggests that certain services to be offered by Applicant are factors that may impact a person’s well-being. Consequently, the use of the term “HEALTH” within Applicant’s mark, when used in connection with Applicant’s listed services, does not immediately define the service with any degree of particularity.

The term “HEALTH,” similar to “technology,” “intelligent,” or “emotional,” includes many different attributes, but does not convey an immediate idea of the qualities or characteristics of any related goods or services. See In re Hutchinson Tech. Inc., 7 U.S.P.Q.2d 1490 (Fed. Cir. 1988). As stated in Hutchinson, the fact that the term “technology” is used in connection with computer products does not mean that the term is descriptive of those products. Id. at 1492. Many goods may be included within the broad term “technology,” but that does not

make the term descriptive of all those goods. Id. The same logic pertains to words like “intelligent” or “emotional,” which have been registered with the U.S. Patent and Trademark Office numerous times as part of a mark without disclaimer.

Simply put, the term “HEALTH” is a very broad term that connotes many categories of physical, mental, and social attributes without conveying an immediate idea of the qualities or characteristics of any one of the attributes with respect to Applicant’s listed services. Therefore, the Examining Attorney has failed to satisfy her burden of proof that the term “HEALTH” is merely descriptive of the services to be offered by Applicant.

B. The term “HEALTH” is suggestive of the listed services because it requires thought, imagination and perception to know the specific types of services to be provided by the Applicant.

The fact that “HEALTH” may be a desirable by-product of a consumer’s use of some of the listed services does not mean that the term is descriptive of such services. If one must exercise mature thought or follow a multi-stage reasoning process in order to determine what service characteristics are indicated by the term, the term is suggestive rather than merely descriptive. In re Tennis in the Round, Inc., 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978). The term “HEALTH” is suggestive because some thought or perception is needed to understand that “health” is the state of being a person may achieve in connection with the use of some of Applicant’s services.

Applicant, rather than literally providing “health,” will provide services that consumers hope will lead to good “health.” For instance, a consumer may work out at a physical fitness center or attend a class offered by Applicant that may lead to his or her better physical, mental, or social well-being. Accordingly, the term “HEALTH” is one step removed from being merely descriptive because it only suggests the result to be achieved by the consumer through the

services to be offered by Applicant. This multi-stage reasoning process embodies thought and imagination, which are the touchstones of a suggestive term. Rather than being merely descriptive, the term “HEALTH” is suggestive of the state of being a person may achieve in connection with the use of certain aspects of Applicant’s services and, therefore, no disclaimer is required.

II. THIRD PARTY REGISTRATIONS DEMONSTRATE A LACK OF CONCLUSIVE EVIDENCE THAT THE TERM “HEALTH” IS MERELY DESCRIPTIVE.

Applicant recognizes that each case is decided on its own facts and that prior decisions and actions of other trademark examining attorneys in registering different marks are not binding upon the U.S. Patent and Trademark Office. See In re Int’l Taste, Inc., 53 U.S.P.Q.2d 1604, 1606 (T.T.A.B. 2000). However, the Examining Attorney attached eight third-party registrations to her Final Office Action, dated February 23, 2009, that disclaimed the term “HEALTH” and that listed services similar to Applicant’s. The Examining Attorney argued that these third-party registrations were probative evidence that the term “HEALTH” was merely descriptive. However, of the eight third-party registrations, only two of the registrations disclaimed just the term “HEALTH.” The other six third-party registrations disclaimed a phrase that contains the term “HEALTH.” For example, “health club(s),” “health system,” “health club and spa,” “kids health club.com,” and “health and fitness.” In contrast to the single term “HEALTH,” these phrases might be descriptive because of the other terms used in the phrase.

Furthermore, Applicant found 272 live records on the Principal Register of third-party registrations featuring similar services in the same classification as Applicant that were not required to disclaim the term “HEALTH.” These records do not contain registrations issued under Section 2(f) of the Trademark Act because of acquired distinctiveness. An identical search

for third-party registrations featuring similar services that have disclaimed the term “HEALTH” yields only 482 live records. These records support the Applicant’s position that there is a lack of conclusive evidence that the term “HEALTH” is merely descriptive based on third-party registrations for similar services.

We selected ten samples from the 272 registrations for illustrative purposes and attached them to the Request for Reconsideration, filed on June 12, 2009. In much the same way as Applicant’s mark, these marks contain “HEALTH” in a purely suggestive capacity. For example:

- BURN IN HEALTH (Reg. No. 3,602,909): health club services, namely, providing instruction and equipment in the field of physical exercise; physical fitness consultation and instruction.
- HEALTH IN THE CITY (Reg. No. 3,591,734): physical fitness instruction.
- THINK HEALTH (Reg. No. 3,237,817): education services, namely conducting classes, seminars, lectures, training, conferences, programs and workshops on the fields of health, well-being and holistic healing.
- RADIANT HEALTH YOGA (Reg. No. 2,727,232): yoga instruction, namely, classes, workshops, private sessions and teacher training in the field of yoga.
- MORE HEALTH (Reg. No. 2,509,612): development of educational materials and printed instructional, education, and teaching materials to promote health and safety education for kindergarten through 12th grade school age children.
- SCRIPPS HEALTH (Reg. No. 2,066,118): educational services, namely, conducting classes and seminars on general health issues.

Being suggestive, these applications were not required to disclaim the term “HEALTH” as a condition to registration. If the sample marks that deal with physical fitness centers, exercise facilities and educational services are not required to disclaim “HEALTH,” then it should follow that Applicant’s mark need not either, because the use of “HEALTH” in Applicant’s mark is at least as suggestive as the use in the sample marks. Moreover, because several third-party

registrations were not required to disclaim the term, there is no conclusive evidence that the term “HEALTH” is merely descriptive.

III. DOUBTS RESOLVED IN FAVOR OF APPLICANT.

When there is doubt about whether a term is descriptive or suggestive when used in connection with an identified service, doubt must be resolved in favor of the applicant and publication of the designation for potential opposition. See In re Grand Metropolitan Food Service, Inc., 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1994); In re Intelligent Medical Systems, Inc., 5 U.S.P.Q.2d 1674, 1676 (T.T.A.B. 1987); In re Aid Laboratories, Inc., 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983).

IV. CONCLUSION

For the reasons set forth above, Applicant submits that that the Examining Attorney did not meet her burden of proof that the term “HEALTH” in Applicant’s mark is merely descriptive, because the term is, in fact, suggestive. Accordingly, Applicant respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney’s decision requiring a disclaimer of the term “HEALTH” prior to registration of Applicant’s mark.

Respectfully submitted:



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TABLE OF CASES

In re Aid Laboratories, Inc., 221 U.S.P.Q. 1215 (T.T.A.B. 1983).

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